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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONLETH S. O'CONNELL and MARK SCHEEVEL

Appeal 2008-1044
Application 09/965,914¹
Technology Center 2400

Decided: ² May 26, 2009

Before ALLEN R. MACDONALD, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

¹ Application filed September 28, 2001. The real party in interest is Vignette.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a non-final rejection (twice-rejected) of claims 1-61 mailed April 11, 2006, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellants invented a system and method for providing cache management and regeneration of dynamically-generated content (“DGC”) in a client-server computer network. (Spec. 44, Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-61. Claims 1, 23, and 43 are independent claims. Claim 1 is illustrative:

1. A method for cache management and regeneration of dynamically-generated content (“DGC”) in one or more server computers within a client-server computer network, comprising the steps of:

in response to a regeneration event, identifying a set of one or more previously cached DGC components affected by said regeneration event;

regenerating a new version of each affected DGC component in said set to incorporate a criteria associated with said regeneration event; and

replacing each affected DGC component in said set with said respective new version of each.

C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Li	US 6,591,266 B1	Jul. 8, 2003 (Effective Filing July. 14, 2000)
Carlson	US 6,697,849 B1	Feb. 24, 2004 (Filed May 1, 2000)

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-61 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Carlson.

II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on December 22, 2006. The Examiner mailed an Examiner's Answer (Ans.) on April 13, 2007. Appellants filed a Reply Brief (Reply Br.) on June 13, 2007.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Declaration

1. In the Declaration, Appellants submit that “the patent application was conceived at least as early as January 7, 2000.” (Declaration, item 2.)

2. In the Declaration, Appellants submit that “I drafted and sent the email attached as Exhibit A on January 7, 2000.” (Declaration, item 3.)

3. In the Declaration, Appellants submit that “Exhibit B demonstrates a conception of the invention described and claimed in the above-referenced patent application at least as early as the date of the email: January 7, 2000.” (Declaration, item 5.)

IV. PRINCIPLES OF LAW

Declaration under 37 C.F.R § 1.131

§ 1.131 Affidavit or declaration of prior invention:

(a) When any claim of an application ... is rejected, the inventor of the subject matter of the rejected claim ... may submit an appropriate ... declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based....

(b) The showing of facts shall be such, in character and weight, as to establish [1] reduction to practice prior to the effective date of the reference, or [2] conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent [actual] reduction to practice or to the filing of the application [i.e., a constructive reduction to practice]. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the ... declaration or their absence must be satisfactorily explained.

A declaration submitted pursuant to Rule 131 is evaluated on its merits by considering the evidence relied upon in light of the arguments

made explaining why the evidence is sufficient. The Board has broad discretion as to the weight to be given the evidence. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004); *In re Inland Steel, Co.*, 265 F.3d 1354, 1366 (Fed. Cir. 2001).

“Under 37 C.F.R. § 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).” MPEP § 715.07(a) (8th ed. 2008).

35 U.S.C. § 103(a)

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief has not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

V. ANALYSIS

Grouping of Claims

In the Brief, Appellants argue claims 1-61 as a group (App. Br. 9-12). For claims 2-61, Appellants repeat the same argument made for claim 1. We will, therefore, treat claims 2-61 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

Sufficiency of Declaration under 37 C.F.R. § 1.131

We first consider the Examiner's findings that the Declaration submitted on February 23, 2006 under 37 C.F.R. 1.131 is ineffective to overcome the Li reference.

Appellants contend:

The Declaration avers to the fact that the present invention was conceived at least as early as January 7, 2000 and the corresponding Office Actions state that constructive reduction to practice occurred on September 29, 2000 with the filing of the provisional application. The Examiner has failed to consider the merits of the Declaration because the Examiner applied an inappropriate standard, apparently looking for proof of reduction to practice rather than conception.

(App. Br. 9.)

Appellants further contend that “the Declaration is used to establish a conception date while the filing date of the provisional application establishes the date of constructive reduction to practice.” (App. Br. 10.)

The Examiner found that “[e]xhibits A and B do not explicitly prove, demonstrate, nor clearly show in details how the claimed invention can be

constructed using information from the email and the outline in the Exhibits A and B” (Ans. 3-4).

Issue: Have Appellants shown that the Examiner erred in finding that the Declaration is insufficient to establish a conception date of the invention prior to the effective date of the Li reference?

Under 37 C.F.R. § 1.131(b), Appellants must establish invention of the subject matter of the rejected claims prior to the effective data of the reference Li (*e.g.*, July 14, 2000). The showing of facts must either (a) *establish reduction to practice prior to the effective date of the reference*, or (b) *establish conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.* (emphasis added).

In this case, Appellants have chosen the second prong of 37 C.F.R. § 1.131(b) and are attempting to establish “conception” of the invention prior to the effective date of Li (FF 1-3). Thus, “reduction to practice” is not an issue in this case.

While we agree with Appellants that it appears that the Examiner is looking for proof of “reduction to practice” rather than “conception” (App. Br. 11), Appellants have failed to recognize that any finding of facts attempting to establish “conception” must also be coupled with facts showing due diligence.

At best, Appellants’ Declaration evidences a “conception” date of the invention prior to Li’s effective date. However, Appellants have not provided any evidence to support the due diligence requirement under 37 C.F.R. § 1.131(b). In fact, we find Appellants Briefs are completely silent

regarding the requisite showing of due diligence. In other words, Appellants have not shown due diligence from July 13, 2000 (which is one day prior to the effective filing date of the Li reference) to the filing date of Appellants' U.S. provisional application (*e.g.*, September 29, 2000), provided that claims 1-61 are fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application. *See* MPEP § 706.02 (8th ed. 2008).

Thus, Appellants have not shown sufficient evidence, in character and weight, as to establish due diligence. As such, the earliest effective filing date for the present application is therefore the filing date of the provisional application (September 29, 2000) - a date after the effective filing date of the Li reference (July 14, 2000).

Appellants have not presented sufficient evidence to establish conception of the invention prior to the effective date of the Li reference *coupled with due diligence*. Thus, the submitted Rule 1.131 affidavit is insufficient to disqualify Li as a 102(e) reference.

The Obviousness Rejection

We now consider the Examiner's rejection of claims 1-61 under 35 U.S.C. § 103(a) as being obvious over the combination of Li and Carlson.

Given that Appellants' only arguments in the Briefs are focused on antedating the Li reference, which as noted *supra* we find insufficient, we *pro forma* sustain the Examiner's rejection of claims 1-61 under 35 U.S.C. § 103(a) as being unpatentable over Li and Carlson.

VI. CONCLUSIONS

We conclude that Appellants have not shown the Examiner erred in finding the Declaration under 37 C.F.R. § 1.131(b) insufficient.

Thus, claims 1-61 are not patentable.

VII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-61.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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